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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,713	07/30/2003	Susan E. Wrenn	021238-610	5365

7590                    12/19/2007  
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EXAMINER
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FELTON, MICHAEL J

ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
12/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/629,713	WRENN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Michael J. Felton	1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 September 2007.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 28-59 is/are pending in the application.
  - 4a) Of the above claim(s) 28 and 38-59 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 29-37, 60 and 61 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 60 and 61 have been added. The abstract and title of the invention have been amended and the objection to these elements is withdrawn. The amendment of claim 35 has overcome the 35 USC 112 rejection made on 6/29/2007, and therefore this rejection is withdrawn.

### ***Response to Arguments***

2. Applicant's arguments filed 9/28/2007 have been fully considered but they are not persuasive. The applicant alleges that there is insufficient reasons for supporting the combination of admitted prior art to meet claim 29. However, the examiner believes that it is clear that the invention would have been obvious over the stated prior art. To put more clearly, the invention as claimed in claim 29, is the result of two obvious combinations. The first combination is the connection of two existing machines, a cigarette maker and a tipping machine using drums, devices notoriously well known in the art for handling cigarettes. The second combination is the insertion of a laser perforation apparatus in combination with these drums. The laser system is a type of perforation system that would have been obvious to locate at almost any point in the production of the cigarettes. Therefore, the examiner believes, the invention is obvious because neither the linking of two machines, or the use of a laser perforation system, or their use together, would produce unpredictable results, be beyond the skill on one of

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ordinary skill, and would have been obvious to try this arrangement because integrating two devices would result in time and efficiency savings, as well as reduced damage to cigarettes.

3. In addition, it is noted that while the drawings do not show the claimed linkage between the two machines (which is the primary aspect of the invention), the applicant responded to the objection to the drawings by admitting on the record (see Remarks, 9/28/2007, page 18, lines 3-5) that the connections were conventional and need not be shown. Therefore, the examiner believes that the invention as claimed is obvious because it has been admitted on the record that one of ordinary skill would know how to connect the two machines. Therefore the objection to the drawings has been withdrawn.

4. In the second 35 USC 103(a) rejection of claim 29 (including claims 35 and 36), the inclusion of a laser perforation system was inadvertently left out of the discussion. However, the reasons for inclusion of a laser perforation system are identical to the rejection of claim 29 over the admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a laser perforation system at any point during the manufacture and handling of cigarettes and their components, including the handling of cigarettes between the cigarette maker and the tipping machine, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Laser perforation systems are indicated to be known in the prior art.

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5. The applicant alleges that unexpected results (allowing high speed perforation) results from the structure being claimed. This feature is not being claimed.

***Double Patenting***

6. Applicant is advised that should claim 34 be found allowable, claim 61 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

7. Applicant is advised that should claim 35 be found allowable, claim 60 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

8. The applicant should also note that claim 35 and claim 60 have the same misspelling of the word "burn" (see "bum", claim 35, line 7; claim 60, line 12).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art. The applicant admits the following prior art: that tobacco plugs are constructed on a conventional cigarette making machine (page 37, lines 3-4), other suitable plug delivery systems might be employed such as mass flow conveyors or pneumatic tubes or the like (page 37, lines 12-13), garniture operation can be controlled by a double-

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action plug-tube combiner (page 37, lines 15-20, 25-28), any conventional tipping machine can be used (page 41, lines 9-15), any perforating system can be used (page 44, lines 25-28) including a commercially available Hauni 500 (page 45, lines 1-7). It is assumed that the applicant is intending to claim an apparatus to connect a cigarette making machine and a tipping machine (see 112 rejections).

Although a prior art means for connecting a cigarette making machine and a tipping machine is not disclosed, it would have been obvious to one of ordinary skill in the art at the time of invention to combine both machines, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). The admitted prior art also does not disclose a laser perforation apparatus in the connecting means between a cigarette maker and a tipping machine. However, laser perforation apparatus' are well known in the art. In addition, it would have been obvious to include a laser perforation apparatus, which are known in the prior art, at any point along the cigarette making process, including in a connecting means between a cigarette making machine and a tipping machine. It would have been obvious to one of ordinary skill in the art at the time of invention to use a laser perforation system at any point during eh manufacture and handling of cigarettes and their components, including the handling of cigarettes between the cigarette maker and the tipping machine, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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12. Claims 29, 35, 36, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dearsley (US 3,036,581) in view of the applicants admitted prior art. The applicant discusses prior art apparatuses such as a conventional cigarette making machine (page 37, lines 3-4), plug delivery systems such as mass flow conveyors or pneumatic tubes or the like (page 37, lines 12-13), garniture operations that are controlled by a double-action plug-tube combiner (page 37, lines 15-20, 25-28), and conventional tipping machines (page 41, lines 9-15), perforating systems (page 44, lines 25-28) including a commercially available Hauni 500 (page 45, lines 1-7). It is assumed that the applicant is intending to claim an apparatus to connect a cigarette making machine and a tipping machine (see 112 rejections).

Although the applicant discloses that all the components are commercially known, prior art for using a drum to connect two different cigarette machines is not disclosed. However, Dearsley discloses an attachment for a cigarette-making machine that takes discharged cigarette rods and, using a conveying drum, cutting them and then further processing the rods by applying tipping material, thereby connecting the cigarette machine and the tipping apparatus. It would have been obvious to incorporate the disclosure of Dearsley with the disclosed commercially available cigarette making machine and tipping machine disclosed by the applicant because they are analogous art and solve the same problem. The motivation to do so would be to integrate two devices which would result in time and efficiency savings, as well as reduced damage to cigarettes.

13. Claims 30, 31, 32, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dearsley (US 3,036,581), the applicant's prior art, and in further view of Nichols et al. (US 4,570,649). The applicant discloses that a commercially available laser system, that Hauni 500, is used to perforate the cigarettes, however, it is not disclosed what is part of this system and what is the applicants invention. If the laser system only provides laser radiation, then optics and a beam splitter are needed. Dearsley defines the link-up assembly, including a drum with flutes (col. 13, line 5-10), but not laser perforation.

However, Nichols et al. disclose the use of a laser system, beam splitter, and optics to cut two rows of perforations simultaneously into a tobacco rod or cigarette (col. 4, 19-36). It would have been obvious to one of ordinary skill in the art at the time of invention to perforate tobacco rods and/or cigarettes with a laser, such as that disclosed by Nichols et al. The motivation to include laser perforation would have been to produce a perforated product (with different smoking characteristics) as disclosed by Nichols et al. In addition, the lenses of Nichols et al. are capable of burning rows of perforations, as one of skill in the art would know.

14. Claims 34 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dearsley (US 3,036,581), the applicant's admitted prior art, and Nichols et al. (US 4,570,649). The link-up assembly of Dearsley defines a drum with flutes, but Dearsley does not disclose using several specific drums (laser drum, catch drum, separating drum, cutting drum, and swash drum), nor a laser perforation system. Nichols et al.

disclose a laser perforation system that would be obvious to combine with Dearsley (see rejection of claims 30-33).

Neither Dearsley, nor Nichols et al., disclose the multiple drums of the instant application. However, the applicant provides prior art (a portion of fig 9) that discloses the use of these drums in a commercially available system. Elements 238, 250, 260, 261, and 262 show an assembly drum, a swash plate drum, a roll drum, an optional perforation drum, and a cut drum respectively. It would have been obvious to one of ordinary skill in the art at the time of invention to duplicate the parts of the commercial system (admitted prior art) and combine them with the inventions of Dearsley and Nichols et al., since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The motivation to do so would be to perforate different wrappers and work with different arrangements of cigarette assemblies to increase throughput.

### **Conclusion**

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

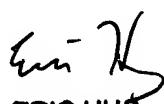
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Felton whose telephone number is 571-272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJF

  
ERIC HUG  
PRIMARY EXAMINER